

REMARKS

Claims 1-16 were allowed in the original prosecution of the patent application. The Examiner has reopened prosecution of the application after payment of the Issue Fee.

The Examiner has required new drawings. Applicants submit herewith the formal drawings which had been provided with a Letter to the Official Draftsman when the Issue Fee was paid.

The Examiner has rejected Claims 12-14 as non-statutory subject matter. Applicants have canceled Claims 12-14. In addition, Applicants have canceled Claims 10 and 11, since the limitations found therein have been incorporated by amendment into Claim 1.

Applicants have added dependent Claims 17-21. No additional filing fee is due, since the total number of claims does not exceed twenty total claims and no additional independent claims have been added.

The Examiner has rejected Claims 1-2, 5-7, 10, 12-13, and 15-16 under 35 USC 102(e) as anticipated by Erol's Structure of Fees; Claims 3-4 under 35 USC 103 as unpatentable over the teachings of Erol in view of the AAPA; and, Claims 8-9, 11, and 14 under 35 USC 103 as being unpatentable over the teachings of Erol. For the reasons set forth below, Applicants respectfully

assert that the claims as amended are patentable over the cited prior art.

The Erol reference is a paper on which is printed a table of fees for services. The Erol paper does not teach or suggest a method, system, or program storage device for a computer processor to provide automatic valuation of server-based computer services for each of a plurality of computer server systems. Applicants have amended the claim language to reflect that the claimed method, system and program storage device are for the automatic creation of the matrix and for automatic valuation of server-based computer services.

With specific reference to the claim language, the present invention provides the steps and means for implementing the steps of assigning a capacity value for each of a plurality of computer server systems, assigning a usage category for each of said plurality of server systems, mapping the capacity value and usage category into a matrix; and automatically assigning costs for server-based computer services based on location within said matrix (Claims 1, 15, and 16). In addition, the present invention teaches (Specification, page 15, line 19-page 16, line 18) and claims means and steps for, in response to a specific request for server-based computer services, determining the required usage type and required capacity for satisfying the request and automatically determining charges for requested

server-based computer services by aggregating the assigned costs for services from the matrix based on the required usage type and required capacity (Claims 17-21) or based on required usage type, required capacity and required support level (Claims 18 and 20).

Applicants respectfully assert that the Erol sheet does not provide anything other than a list of its fees. Erol does not teach a method, a system, or a computer program product for a computer processor to automatically provide valuation of server-based computer services. Erol simply lists fees for different service packages.

For a reference to anticipate another invention under 35 USC § 102(b), that reference must clearly teach each and every claimed feature of the anticipated invention. Since the Erol sheet clearly does not teach a system or steps for automatic valuation of server-based computer services, does not teach the assigning of a capacity value for each server, the assigning of a usage category for each server, the mapping of the capacity value and usage category into a matrix, or the assigning of costs based on location with the matrix, it cannot be maintained that the Erol sheet anticipates each and every claim feature of the independent claims. Accordingly, Applicants respectfully request withdrawal of the anticipation rejection based on Erol.

With regard to the obviousness rejections based on the Erol paper, Applicants note that, to establish a *prima facie* case of

obviousness, the prior art must teach or suggest all of the claim limitations (*In re Wilson*, 424 F. 2d 1382, 165 U.S.P.Q. 494 (C.C.P.A. 1970). The Erol paper does not teach or suggest automatic valuation of server-based computer services, the assigning of a capacity value for each server, the assigning of a usage category for each server, the mapping of the capacity value and usage category into a matrix, or the assigning of costs based on location with the matrix (independent Claims 1, 15, and 16) and further does not teach or suggest the additional claim features related to support levels. The Examiner concludes that "one...would have expected Applicants' invention to perform equally well with Erol...". Applicants fail to see how such an argument is relevant to the patentability decision. In addition, the Examiner stated that "Erol and many ISPs have had their pricing guides based on the various services provided to the customer and the service support level should be obviously considered one of the services which Erol and many other ISPs would have provided". Applicants are not sure what the Examiner is arguing in the foregoing passage. The Erol paper provides no mention of support levels or of automatic mapping of same. Erol simply provides prices for different packages. Absent some teaching or suggestion of the claim features, an obviousness rejection simply cannot be maintained.

The Examiner has additionally cited the Applicant's Admitted Prior Art (AAPA) in rejecting the language of Claims 3 and 4. Applicants reiterate that Erol provides no teaching or suggestion of automatic valuation of server-based computer services, assigning of a capacity value for each server, assigning of a usage category for each server, mapping of the capacity value and usage category into a matrix, or automatic assigning of costs based on location with the matrix. Moreover, even if one were aware of capacity values based on the number of CPUs and/or based on published standards, one would not be motivated to modify Erol with capacity values. In fact, it would not be logical to modify Erol with capacity values, since Erol does not list any package feature which relates to CPUs or specific servers. Further, even if one were motivated to include such information, the combination would not lead to the invention as claimed since, again, neither the AAPA nor Erol teaches or suggests automatic valuation of server-based computer services, assigning of a capacity value for each server, assigning of a usage category for each server, mapping of the capacity value and usage category into a matrix, or automatic assigning of costs based on location with the matrix.

Based on the foregoing amendments and remarks, it is respectfully requested that the objections/rejections to this Application be reconsidered and withdrawn, the amendments made to the claims be approved, and the Claims 1-9 and 15-21, as amended, be passed to issuance.

Respectfully submitted,

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